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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,981	07/03/2003	Louis Brown Abrams	4811-14	4355
22442	7590	01/30/2006	EXAMINER	
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/613,981

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1, 2, 5-7, 12/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 1-18, 23-30, and 35, in the reply filed on November 14, 2005, is acknowledged. Claims 19-22 and 31-34 are hereby withdrawn as non-elected.

### *Priority*

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosures of the prior-filed applications, Application Nos. 60/393,362, 60/416,098, and 60/443,986, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Specifically, said prior-filed applications fail to provide support for the claimed elastic film and second, discontinuously distributed, adhesive layer.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “30” has been used to designate both the transfer of Figure 2 and the substrate of Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following figures not mentioned in the description: Figures 5 and 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 29 and 30, submitted in the Preliminary Amendment filed September 30, 2003, are considered to be new matter despite applicant's assertion thereto. Specifically, applicant asserts support for said claims can be found in copending application 10/265,206 and US Patents 6,110,560 and 6,010,764, which were all incorporated by reference into the present application. While the cited application and patents do disclose pressure sensitive adhesives, said adhesives are not equivalent to the presently claimed "second...adhesive layer." In particular, the secondary adhesive disclosed in the patent application is descriptive of a release adhesive on the secondary carrier, not an adhesive as presently claimed bonded to the second side of the film substrate. Thus, claims 29 and 30 are rejected for containing new matter.

***Allowable Subject Matter***

7. Claims 1-18 and 23-28 allowed.
8. Claim 35 is objected as being dependent upon a non-elected claim.

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9. The closest prior art includes (a) US 5,597,637 issued to Abrams et al., (b) JP 2001-270019 assigned to Shingii, (c) 4,438,533 issued to Hefele, and (d) US 2005/0136211 issued to McGovern et al.

10. Abrams discloses an elastomeric flock transfer comprising a stretchable hot melt so that the transfer may stretch when applied to a stretchable substrate without cracking or splitting (abstract). However, the stretchable substrate to which the transfer is applied is a garment or clothing. As such, there is no motivation to apply a second discontinuously distributed adhesive on the opposite side of said garment (i.e., side of garment adjacent the wearer).

11. Shingii teaches a flocked fibers adhered to an elastic sheet of waterproof, foamable chloroprene rubber. Said flocked elastic sheet is employed for protective sports clothing, such as a wet suit, or sports accessories, such as a glove or padding. Like with the Abrams invention, there is no motivation to apply a second discontinuously distributed adhesive on the opposite side of said wet suit, glove, or padding.

12. Hefele discloses an interlining for garments comprising a backing material, such as a knitted fabric, flock fibers adhered to said fabric by means of an adhesive layer, and a second discontinuous adhesive on the opposite side of said backing material (abstract and Figure). Thus, Hefele teaches the limitations of claim 1 with the exception that the backing material is an elastic film. However, there is no proper motivation for one skilled in the art to substitute an elastic film for the fabric interlining substrates of the Hefele invention.

13. McGovern teaches flock fibers adhered to an elastomeric film substrate to form a light shielding or teremp cloth, which is adhered film canister or shell. Thus, McGovern teaches the presently claimed invention with the exception that the adhesive employed to bond the cloth to

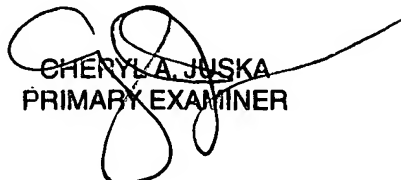
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the shell is discontinuously distributed. While it might be obvious to one skilled in the art to employ said adhesive in a discontinuous manner, the McGovern reference is not available as prior art in that the effective filing date of the present invention pre-dates the effective filing date of said reference.

*Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
January 23, 2006